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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,721	03/11/2005	Clifford L. Jordan	P56713US	8538

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EXAMINER
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MATTER, KRISTEN CLARETTE

ART UNIT	PAPER NUMBER
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3771

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03/30/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/522,721	<b>Applicant(s)</b> JORDAN, CLIFFORD L.	
	<b>Examiner</b> KRISTEN C. MATTER	<b>Art Unit</b> 3771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 54-64 and 71-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 76 is/are allowed.
- 6) ☐ Claim(s) 54-64 and 71-75 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This Action is in response to the Appeal brief filed 8/14/2008. After consideration of the Appeal brief, prosecution has been reopened. No claims have been amended, added, or cancelled by the communication filed 8/14/2008. Thus, claims 54-64 and 71-76 are currently pending in the instant application.

In view of the Appeal Brief filed on 8/14/08, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Justine R Yu/  
Supervisory Patent Examiner, Art Unit 3771.

***Allowable Subject Matter***

Claim 76 is allowed over the prior art of record.

The indicated allowability of claims 54-58, 60-64, and 71-75 is withdrawn in view of reconsideration of the reference US 6,820,616. Rejections based on the cited reference(s) follow. Examiner sincerely apologizes for any inconvenience this may have caused.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 59-64 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 19-21, 23, 24, 28, and 39 of U.S. Patent No. 6,820,616 B1.** Although the conflicting claims are not identical, they

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are not patentably distinct from each other because for example, instant claim 59 has everything as recited in the patented claim 21 including a controller. The only difference is the recitation of a control panel with a “mode selection switch.” However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a control panel to US’616’s controller so that the user can adjust the settings via the switches. Note that the controller controls the operation of the gas system, which comprises the first, second, and third units and the common gas system (see patented claim 21), it is considered that the controller is coupled to all the units and the common gas system for providing the controlling function. The limitation of control panel is also found in the patented claim 39. In addition, having a switch in a control panel is a well-known feature for controlling a system. The limitation of a switch is also found in the patented claim 39. Thus, any infringement over the patent would also infringe on the instant claims.

The limitations of claim 60 can be found in patented claim 20 (again it would have been obvious to include a control panel with a mode selection switch for the device with four testing units instead of three). The limitations of claim 61 can be found in patented claim 21. The limitations of claim 62 can be found in patented claim 23. The limitations of claim 63 can be found in patented claim 24. The limitations of claim 64 can be found in patented claim 28.

**Claims 54-58 and 71-75 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 4, 7,**

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**9, 17, 21, 26, and 27 of U.S. Patent No. 6,820,616 B1 in view of Sherrod (US**

**5,979,444 A).** Although the conflicting claims are not identical, they are not patentably distinct from each other because for example, instant claim 54 has everything as recited in the patented claim 1 except the recitation of a “regulator enable valve.” However, regulator enable valves are well known and commonly used in the art. For example, Sherrod discloses a breathing apparatus with a regulator enable valve (22) coupled to a pressure regulator (90) to control the pressure of air flowing through the regulator. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a regulator enable valve as taught by Sherrod and is well known in the art to US’616’s system so that the pressure of air flowing through the regulator can be accurately controlled to provide breathable air at a safe pressure to a user.

The limitations of claim 55 can be found in patented claim 4. The limitations of claim 56 can be found in patented claim 7. The limitations of claim 57 can be found in patented claim 9. The limitations of claim 58 can be found in patented claim 17. The limitations of claim 71 can be found in patented claims 26 and 27.

The limitations of claims 72, 73, and 75 can be found in patented claim 21. As discussed above, the addition of a regulator enable valve as taught by Sherrod would have been obvious to one of ordinary skill in the art at the time the invention was made as would have the addition of a control panel to US’616’s controller so that the user can adjust the mode settings via the switches (and accordingly the valves). The limitations of claim 74 can be found in claims 26 and 27.

### ***Response to Arguments***

Applicant's arguments filed 8/14/2008 have been fully considered but they are not persuasive.

#### **A. Authority to reject a claim filed in a divisional application under the doctrine of non-obviousness double patenting**

In response to appellant's argument that the claims are prohibited from being rejected by obviousness type double patenting because the instant application is a divisional application of the parent case US 6,820,616, examiner respectfully notes that the Office has no record of an application data sheet ("ADA") being submitted at the filing of the instant application. It is unclear where the ADA copied on page 26 of the appeal brief is located in the application record. The requirements for claiming benefit (i.e., either within the ADA or in the first sentence of the specification) are laid out in the final rejection of 9/27/2007. Accordingly, this application was not properly claimed as a divisional application within the required time period and as such, the claim for priority was not granted (i.e., there is no record of an ADA and the specification was not amended with the required four or sixteen month time period) . Therefore, the patent is not prohibited from being used in a double patenting rejection.

Additionally, appellant comments that the restriction in the parent case was withdrawn on pages 27-28 of the appeal brief. However, after review of the parent file wrapper, examiner sees no indication that the requirement was clearly withdrawn. If the restriction requirement was withdrawn, the parent case is not prohibited from being

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used in an obviousness type double patenting rejection because under the guidance given to examiners as set forth in the MPEP §804.01 (E), (F), and (G), once a restriction is withdrawn in a parent case before issuance of the patent, the patent is not prohibited under 35 USC §121 from being used in an obviousness type double patenting rejection.

Additionally, if the restriction was not withdrawn, as noted in the MPEP §804.01, when an identical invention is claimed in both the patent and a pending application (as is the case here with the apparatus claims), “the Office will make a double patenting rejection because a patentee is entitled to only a single patent for an invention.” Here, the same device is being claimed in the patent and the instant application. The restriction requirement in the parent case was between an apparatus and a method of using that apparatus. The apparatus claims were elected, examined, and issued as a patent. Accordingly, only the method claimed in instant claim 76 is prohibited from being rejected by the parent patent by 35 USC §121 because it is a separate and distinct invention from the patented apparatus.

**B. 35 USC §121 does not mandate an absolute prohibition**

As noted above, the Office has no record of an ADA and accordingly, the claim for priority was not timely submitted.

However, even if the instant case is considered a division of the patented case, the patent is still not barred from being used in an obviousness type double patenting rejection because the restriction requirement in the patent was between an apparatus and a method of using that apparatus. The apparatus was elected, examined, and issued as a patent. Accordingly, the Office will not grant two patents for the same



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invention and only the claimed method of operating the system is barred from an obviousness type double patenting rejection by the parent case.

### **C. Style of claims**

As discussed above, the patent is not barred from being used in an obviousness type double patenting rejection because the restriction requirement in the patent was between an apparatus and a method of using that apparatus. The apparatus was elected, examined, and issued as a patent. Accordingly, the Office will not grant two patents for the same invention and only the claimed method of operating the system is barred from an obviousness type double patenting rejection by the parent case.

Appellant argues that the structure of the claims defines a “method of operating.” However, this is not convincing because the structural limitations of the instant claims are in the patented claims and any infringement over the patented system would clearly infringe on the instant application. The only claim defining a method of operating the gas system is instant claim 76, which has been indicated as allowable over the prior art of record.

### **D. Prima Facie case of obviousness**

Appellant argues that a control panel having a “mode selection switch” is not an obvious modification to the patented claims to one of ordinary skill in the art. However, this is not found convincing. “Panels” are well known and commonly used to hide/insulate electrical components from a user and the term “mode select switch” provides no definite structural limitation other than being a switch capable of controlling flow of air through the compressors. The patent claims a controller with switches for

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operation of the various tests of the system. Accordingly, examiner maintains that whether or not the patent specifically claims the switch as a "mode select switch" is not a patentable distinction because the patented switch controls the same various tests and structure as the instant claims and therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have designed the switches to control the flow of air through the compressors because this how the tests are performed in the patented claims as well as the instant claims. Additionally, it is obvious that a system with multiple testing units and a controller will need a means of switching between the various tests and controlling the individual components of the system. Similar arguments hold for providing the system with a "regulator enable valve."

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTEN C. MATTER whose telephone number is (571)272-5270. The examiner can normally be reached on Monday - Friday 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kristen C. Matter/  
Examiner, Art Unit 3771

/Justine R Yu/  
Supervisory Patent Examiner, Art Unit 3771